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SCHWEGMAN, LUNDBERG & WOESSNER/OPEN TV

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BLAIR, DOUGLAS B

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CRAIG D. ULLMAN, MICHAEL R. ABATO,
JEFFREY M. HARRINGTON, and CARL R. DUDA

Appeal 2010-002914
Application 09/409,305
Technology Center 2400

Before JOSEPH L. DIXON, JEAN R. HOMERE, and STEPHEN C. SIU,
Administrative Patent Judges.

DIXON, *Administrative Patent Judge.*

DECISION ON APPEAL ¹

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

I. STATEMENT OF THE CASE

A Patent Examiner rejected claims 149-183. The Appellants appeal therefrom under 35 U.S.C. § 134(a). We have jurisdiction under 35 U.S.C. § 6(b).

We affirm-in-part.

A. INVENTION

The invention at issue on appeal relates to:

Systems consistent with the present invention combine broadcast television programming and/or video programming which appears on a VHS or Beta tape, CD-ROM, DVD or other medium, or particular content from the Internet, or video programming at a video server (hereinafter "video programming") with the massive Internet, creating a new and powerful educational and entertainment medium. The system allows consumers to receive more information in a more efficient manner than either television or the Internet alone. Consumers not only can see a news report on television, but they can also read pertinent information about the report, as well as explore related information about the story. The program becomes the introduction to a particular subject, rather than the entire subject itself. The act of viewing a program has now become a more engaging, enriching experience.

The system can also create a more intimate relationship between the viewer and the program. The user might be solving problems or performing virtual experiments on the Internet site that a teacher is discussing in an educational television program. Similarly, the consumer might be solving problems that

the fictional characters in a television program must solve. In both cases, the consumer is an active participant in the process, rather than a passive observer. Instead of an undirected and unfocused exploration of Internet sites, by synching specific Internet pages to the video signal, the system puts the Internet in context. The television program producers now can decide what additional information to offer their audience. This material can now be seen in the context of the television program.

(Spec. 3-4.)

B. ILLUSTRATIVE CLAIM

Claim 149, which further illustrates the invention, follows.

149. A method for compiling and maintaining information for use in routing and transmitting content to a machine via a network, the method comprising:

receiving user activity information from the machine;

updating a user profile based on the received user activity information;

determining a uniform resource identifier for identifying audio or video content to transmit to the machine based on the received user profile information;

inheriting user profile attributes into the user profile from a group of which the user is a member; and

storing the user profile information in a hierarchical attribute value-pair data structure,

wherein the audio or video content is selected based on the user

profile and the audio or video content is used to enhance an audio video program.

C. REFERENCES

The Examiner relies on the following references as evidence:

Kingdon	US 5,784,560	Jul. 21, 1998
Rangan	US 6,006,265	Dec. 21, 1999

D. REJECTIONS

Claims 149-183 are rejected under 35 U.S.C. 103(a) as being unpatentable over to Rangan in view of Kingdon.

II. ISSUE

Has the Examiner set forth a sufficient reasoned conclusion of obviousness over the combination of Rangan and Kingdon?

III. PRINCIPLES OF LAW

35 U.S.C. § 103

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. *See In re Fine*, 837 F.2d 1071, 1073 (Fed. Cir. 1988). In so doing, the Examiner must make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966). “[T]he Examiner bears the initial burden, on review of the prior art or on any other ground, of

presenting a *prima facie* case of unpatentability.” *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992). Furthermore,

‘there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness’ . . . [H]owever, the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.

KSR Int’l Co. v. Teleflex Inc., 550 U.S. 398, 418 (2007)(quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)).

The question of obviousness is "based on underlying factual determinations including . . . what th[e] prior art teaches explicitly and inherently" *In re Zurko*, 258 F.3d 1379, 1383 (Fed. Cir. 2001).

“A reference may be said to teach away when a person of ordinary skill, upon [examining] the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant.” *Para-Ordnance Mfg. v. SGS Importers Int’l, Inc.*, 73 F.3d 1085, 1090 (Fed. Cir. 1995) (alteration in original) (quoting *In re Gurley*, 27 F.3d 551, 553 (Fed. Cir. 1994)). The prior art’s mere disclosure of more than one alternative does not constitute a teaching away from any of the alternatives when the disclosure does not criticize, discredit, or otherwise discourage the solution claimed. *In re Fulton*, 391 F.3d 1195, 1201 (Fed. Cir. 2004). What the prior art teaches and whether it teaches toward or away from the claimed invention are determinations of fact. *Para-Ordnance Mfg.*, 73 F.3d at 1088.

V. ANALYSIS

With respect to independent claim 149, Appellants argue:

B) The combination of Rangan and Kingdon is improper.

When combining the features of two references provides an inoperative result, and/or the references teach away from such a combination, then there is no proper motivation to combine them. This is precisely what occurs with the combination of Rangan and Kingdon, as proposed by the Office.

(Brief 12). The Examiner provides a further discussion in the responsive arguments at pages 5-6 of the Answer addressing Appellants' argument. Appellants restate the case law in the Reply Brief at pages 1-2, and Appellants further argue that the fact that the references can be combined does not mean that the references should be combined. (Reply Br. 2-3).

Appellants argue:

Thus, if the strictly regulated use of inheritance, as taught by Kingdon, is added to the dependence on dynamic change taught by Rangan, an inoperative system results. This is because attempts to dynamically incorporate attribute changes within a user profile are illicit, according to Kingdon, and will be denied. See *Id.* at Col. 8, lines 19-21. However, if such modifications are prevented, as taught by Kingdon, the system of Rangan that implements this mechanism will cease to provide different interpretations for a hyperlink based on the "expressed preferences of the SUV [subscribers/users/viewers]". See Rangan, Abstract and Col. 9, lines 4-13. This defeats the fundamental purpose of Rangan.

(Brief 13). We have considered Appellants' arguments and find them to be unpersuasive of error. While Appellants' arguments tend to imply that a combination of teachings of Kingdon and Rangan may not be optimal in all

situations, the Examiner's proposed combination as set forth in the rejection in the Answer does not appear to be unreasonable. We find that neither reference may be said to expressly teach away from the proffered combination. In particular, a person of ordinary skill, upon examining either reference, would not be discouraged from following the path set out in the reference, nor would be led in a direction divergent from the path that was taken by the Appellants. Additionally, we find no disclosure which criticizes, discredits, or otherwise discourages the solution achieved from the combination. Therefore, we find Appellants' argument regarding the combination and a teaching away to be unpersuasive of error in the Examiner's showing of obviousness. Therefore, we will sustain the rejection of independent claim 149 and independent claim 158, 164, 170, and 175 grouped therewith since Appellants have not set forth separate arguments for patentability.

Appellants have not set forth separate arguments for patentability of any of the individual dependent claims. Therefore, the dependent claims will fall with their respective independent claims.

Only those arguments actually made by the Appellants have been considered in this decision. Arguments which the Appellants could have made but chose not to make in the Briefs have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37 (c)(1)(vii) (2008).

Appellants have argued in the Reply Brief at page 3 that "the office did not articulate in which references, and wherein those references various elements recited in claims 150-183 could be found. This lack of specificity was finally remedied in the Answer, at least with respect to claims 150-157." We note from the prosecution history that the Examiner set forth the

statement of the rejection in the non-final office action, mailed May 21, 2008, rejecting all the claims as a single group. Subsequently, the Examiner did not individually address the claims on page 2 in the final rejection and stated that "[t]he rejections are maintained from the prior office action mailed on 5/21/2008."

In response to the arguments the Examiner states:

Specifically, the applicant's vaguely disclosed and broadly claimed concept of inheritance cannot be in any way viewed as being patentably distinct from the concept of taking information for a single user from a the properties of that user's neighborhood; a concept clearly laid out in the rejection as being taught by Rangan. The applicant has not even made an attempt to explain how this concept shown in the rejection is not inheritance. Instead the applicant makes technical arguments against the rejection that do not seem to be based on factual evidence or sound reasoning. For these reasons the rejection is maintained.

(Final Rejection 2). While we agree with the Examiner as stated above, the Examiner has the initial burden to set forth the statement of the rejection of the claims (which was well met by the Examiner previously with other prior art references prior to the most recent Request for Continued Examination (RCE)).

Appellants set forth in the Reply Brief three specific claims and arguments for patentability where the Examiner has not specifically addressed the claim limitations, and we do not readily find the teachings in the enumerated locations identified by the Examiner for the rejection of claims 150-157 which were specifically addressed by the Examiner.

Therefore, we are left to speculate as to the application of the prior art teachings. Therefore, we find that the Examiner has not met the initial

burden to establish a prima facie showing of obviousness with respect to claims 170, 171, and 174, and we must reverse the Examiner's rejection thereof.

VI. CONCLUSION

For the aforementioned reasons, the Appellants have not shown error in the Examiner's showing of obviousness of independent claim 149 and claims 150-169, 172, 173, and 175-183 fall therewith since separate arguments for patentability have not been set forth in Appellants. The Examiner has not shown a reasoned conclusion of obviousness for dependent claims 170, 171, and 174.

VII. ORDER

We affirm the obviousness rejections of claims 149-169, 172, 173, and 175-183. We reverse the obviousness rejections of claims 170, 171, and 174.

AFFIRMED-IN-PART

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